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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,028	12/29/2000	Kristin Carman	06975-139001/Packaging 01	6435
26171	7590	09/16/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				RETTA, YEHDEGA
ART UNIT		PAPER NUMBER		
3622				

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/750,028	CARMAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Yehdega Retta	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 April 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-49 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-49 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to the second (supplemental) reply (Declaration) filed on June 07, 2005 and to Appeal Brief filed July 05, 2005. The declaration submitted by applicant has been considered and accepted therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flores (US 6,454,609) and further in view of Official Notice.

Regarding claims 1, 5, 6, 8, 9, Flores teaches a case comprising of a first side and second side connected as to permit one side to move relative to the second side (see fig. 6&7); first side structured and arranged to define a viewing window (see col. 7 lines 6-16). Flores teaches that the viewing proving one viewing window (116). Flores is silent to providing a viewing window exposing only portion of the surface of a disk, the portion of the disk case viewable through the viewing window. Official Notice is taken that is old and well known in the art of packaging disc to cover part of the disk or compact disk with marketing information or label. For example it is well known for AOL to provide a viewing window constituting less than all of the surface of a disk, inserted in a case, and the portion of the disk inserted in the case viewable through the viewing window (see e.g. AOL's CD package as indicated in the article AOL Virtual Museum,

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[www.brainblips.com/aol/aol3.0.0.html](http://www.brainblips.com/aol/aol3.0.0.html), version 3.0 – 50 Free hours package serial, 1997, see page 1 and 5, version 3.0 – 15 Free hours, 1997 see page 3, version 3.0? – 50 Free hours, 1994-1997, see page 4 and 6). AOL teaches the viewing window positioned in different part of the case. AOL, as indicated in the article, teaches marketing information positioned so that only portion of the disk or compact disk is covered, allowing portion of the disk or compact disc in a case to be viewable through a viewing window. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to put the marketing information or labels, as in AOL, on portion of the first side of Flores's case, so either the cover, or front page or pamphlet or the disk as in Flores (see col. 7 lines 10-16) could be viewed when the disc storage container is closed, as indicated in Flores.

Regarding claims 2, Flores teaches a case comprising of a hole (see fig. 2 and col. 4 lines 28-41).

Regarding claims 3, 4, 7, 31 and 32, Flores teaches substantially transparent or clear material provided to affect first viewing characteristic (see Flores col. 7 lines 33-39 and see also AOL e.g. version 3.0 – 50 Free hours package serial, 1997, see page 1 and 5, version 3.0 – 15 Free hours, 1997 see page 3, version 3.0? – 50 Free hours, 1994-1997, see page 4 and 6).

Regarding claims 5, 6 and 33 and 34, Flores teaches more than one viewing window defined by the first side and second side (when the disc is place in the case (126), it suggests that the disc will cover the second side (lower housing section (104)) creating more than one viewable window).

Regarding claims 10-16, Flores teaches first side and second side form a closed cavity and the viewing window enabling perception of the closed cavity (see fig. 2 & 6 and col. 6 line

53 to col. 7 line 16); a disk securing member located with the closed cavity (see fig. 2); an inner surface member (see fig. 1); dimension of the case being greater than Jewel case (see col. 4 lines 5-62); compact disk within the case (see col. 9 line 43 to col. 10 line 67);

Regarding claims 17 and 18, Flores teaches compact disk storing electronic marketing materials comprising computer software (see background and col. 1 lines 27-43). AOL also teaches compact disk storing electronic marketing materials.

Regarding claims 19-21, Flores teaches a disk protecting member position around the perimeter to the compact disk (see fig. 2 and 6).

Regarding claims 22, 23, 43 and 44, Flores teaches removable attachment of a cover, pamphlet, brochure, booklet or the likes in the upper housing section, which suggest that front section of the pamphlet or brochure or booklet can be seen when the case is closed (see col. 7 lines 6-16).

Claim 29 is rejected as stated above in claims 1.

Claim 30 is rejected as stated above in claim 2.

Claims 35-40 are rejected as stated above in claim 10-16.

Claim 41 is rejected as stated above in claim 18.

Claim 42 is rejected as stated above in claim 20.

Regarding claims 24-28 and 45-49, Flores teaches marketing information printed on the label affixed to the case, however does not teach first side of a label containing information identifying intended recipient. Official Notice is taken that is old and well known in the art of mailing of disc or jewel cases to put first side of the label containing information identifying intended recipient. For example, AOL has been known to use a postal package, transparent, with

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a cut-out window for mailing a disk wherein the front being marked with an address and postage stamp been affixed. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Flores case by printing recipients address and affixing a postage stamp for the intended use of mailing the package to recipient. It is also well known to provide a wrapper around a case. It would have been obvious to one of ordinary skill in the art at the time of the invention to wrap a case before shipping it to recipient. One would be motivated to wrap the case before mailing it, in order to protect the disk from being used before reaching the intended recipient. No patentable weight is given to the claimed limitation of position the disk outside the case since what is claimed does not change the structure of the claimed device.

***Response to Arguments***

Applicant's declaration submitted June 7, 2005 has been fully considered and overcome the "105" requirement and the finality of that action is withdrawn. However Applicant's amendment filed September 8, 2005 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR

  
NETTA YEHDEGA  
PRIMARY EXAMINER